

**DETAILED ACTION**

***Priority***

1. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d).

***Election/Restrictions***

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-5 and 10, drawn to a peelable lid membrane with a tab, classified in class 220, subclass 359.2.
  - II. Claims 6-9, drawn to a method of making a peelable lid membrane, classified in class 493, subclass 344.

The inventions are distinct, each from the other because of the following reasons:

3. Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, there are no required steps in the product claims that call for the peelable membrane to be cut from lidding material. The peelable membrane can be made from co-extruding materials together.

Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;
- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);
- (d) the prior art applicable to one invention would not likely be applicable to another invention;
- (e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

**Applicant is advised that the reply to this requirement to be complete must include (i) an election of a invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.**

The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention.

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Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record

showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

5. The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not

commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

6. During telephone conversations with Attorney Vincent Ramik on October 9<sup>th</sup> and October 13<sup>th</sup>, 2008 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-5 and 10. Affirmation of this election must be made by applicant in replying to this Office action. Claims 6-9 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

#### ***Information Disclosure Statement***

7. The information disclosure statement filed January 21, 2005 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referring to the foreign patent documents therein has not been considered.

***Claim Objections***

8. Claims 1, 3-4, and 10 are objected to because of the following informalities: the term "and/or" could be written as "or". Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. **Claims 1-5 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roth et al. (USPN 4,757,914) [hereinafter Roth] in view of Kurita et al. (USPN 6,277,478) [hereinafter Kurita] and further in view of Kubis et al. (USPN 4,834,259) [hereinafter Kubis].**

12. Regarding Claim 1, the patent to Roth – a peelable closure for a container – discloses a peelable lid structure (10) for a container, the peelable lid structure including; a barrier layer (26) for preventing the passage of fluids; and a tab (12) extending from a centre panel of the peelable lid structure (Fig. 1) for removing the

peelable lid structure from the container to allow access to the container contents, with the closure having a barrier layer of aluminum (26).

Roth does not expressly disclose that the aluminum barrier layer is less than 20 microns; however, the patent to Kurita – a peelable sealing cover for a container – discloses a seal cover (**Kurita**, 10) with a layer of aluminum foil (**Kurita**, 5) that has a thickness less than 20 microns (**Kurita**, Co. 2 Lines 52-55). It would have been obvious at the time of the invention to one of ordinary skill, using the teaching, suggestion, and motivation within the prior art, to modify the aluminum barrier layer in the Roth peelable membrane to have a thickness less than 20 microns, as suggested by Kurita, "because it may prevent an injury which the user could otherwise suffer to his or her fingers when removing the seal cover." (**Kurita**, Col. 4 Lines 17-19).

The Roth and Kurita combination does not expressly disclose that the tab is folded over the centre panel and secured in the folded position on the centre panel for processing of can contents and/or handling operations; however, the patent to Kubis – a peelable membrane with foldable tab – discloses a cover (**Kubis**, 16) with a tab (**Kubis**, 18) that is foldable over the center panel (**Kubis**, 28) and is secured onto the cover (**Kubis**, 30, Col. 2 Lines 19-22). It would have been obvious at the time of the invention to one of ordinary skill, using the teaching, suggestion, and motivation within the prior art, to modify the pull tab on the Roth and Kurita combination peelable membrane to be foldable and secured onto the cover during processing of the contents, as suggested by Kubis, so that "the pull tab **18** is stored against damage during the handling of the package **10**." (**Kubis**, Col. 2 Lines 23-25)

13. Regarding Claim 2, Roth in view of Kurita in view of Kubis discloses all the limitations substantially as claimed, as applied to claim 1 above; further, Kurita teaches the aluminum layer is not more than 15 microns in thickness (**Kurita**, Col. 4 Lines 16-19).

14. Regarding Claims 3 and 10, Roth in view of Kurita in view of Kubis discloses all the limitations substantially as claimed, as applied to claims 1 and 2 above, respectfully; further, Roth discloses the peelable lid structure includes one or more of the following layers: polyethylene terephthalate [PET], aluminum (**Roth**, 26) nylon and/or polypropylene (**Roth**, 22 and 24, Col. 2 Lines 16-20).

15. Regarding Claim 4, Roth in view of Kurita in view of Kubis discloses all the limitations substantially as claimed, as applied to claim 1 above; further, Kubis discloses the tab is secured in the folded position by an adhesive and/or by heat sealing (**Kubis**, 30, Col. 2 Lines 19-22).

16. Regarding Claim 5, Roth in view of Kurita in view of Kubis discloses all the limitations substantially as claimed, as applied to claim 4 above; further, Kubis discloses the tab includes a patch, an area of which is exposed by a hole in the tab (**Kubis**, Fig. 3), and the tab is secured in the folded position by the adhesive or heat sealing to the exposed area of patch (**Kubis**, 30, Col. 2 Lines 19-22).

### ***Conclusion***

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: see PTO-892 Notice of References Cited for prior art considered relevant to this application.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT J. HICKS whose telephone number is (571)270-1893. The examiner can normally be reached on Monday-Friday, 8:30 AM - 5:00 PM, EST. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Stashick can be reached on (571) 272-4561. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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